

# Kluwer Patent Blog

## IPCom: Court of Appeal overturns Birss J's finding of non-infringement

Brian Cordery (Bristows) · Wednesday, March 1st, 2017

by Naomi Hazenberg and Olivia Henry

The Court of Appeal has handed down judgment in **IPCom v HTC** ([2017] EWCA Civ 90), the latest instalment of the long running UK litigation on European Patent (UK) 1 841 268. Floyd LJ, writing the leading judgment, allowed IPCom's appeal and dismissed HTC's cross-appeal finding the patent (as amended) to be valid and infringed by HTC phones that comply with the UMTS standard.

The patent relates to the control of access by mobile telephones in a UMTS network to a random access radio channel ("RACH") and is addressed to the problem of contention between signals on the RACH. IPCom had appealed the decision of Birss J dated 24 April 2015 ([2015] EWHC 1034 (Pat)), which found the patent to be valid (as amended) but not infringed by HTC's UMTS mobile phones. In turn, HTC had cross-appealed, challenging the judge's construction and also asserting that the patent (as amended) was invalid for added matter and, in any event, that the amendments should have been rejected on a discretionary basis.

### *Parallel proceedings before the EPO*

Whilst detailed case histories are perhaps ill-suited to blog posts, the life of this patent is more colourful than most and provides crucial context for the issues in dispute between the parties. Granted in 2010, this divisional patent was previously the subject of proceedings between Nokia and IPCom. In that case the Court of Appeal found that the patent (as previously amended) was valid and essential to the UMTS standard and consequently infringed by Nokia's UMTS compliant mobile phones. The patent has also been the subject of EPO opposition proceedings. For the purposes of this decision, readers should note that on 7 March 2013 the Technical Board of Appeal ("TBA") held that a proposed amendment overcame the Opposition's Division's ("OD") objection of added matter. The matter was remitted back to the OD for consideration of novelty and obviousness and is now pending before the TBA again. Due to the suspensive effect of appeals in the EPO, the amendments to the claim approved by the TBA have not yet taken effect.

Although the authentic text of the patent specification is German, the amendment allowed in the Nokia action had put the claims of the EP (UK) into English. At first instance, IPCom applied to amend the principal claim (in English) to bring it into line with the form of the claim approved by the TBA in 2013 (in German). When the TBA hands down its final decision, the the suspensive

effect will cease and the TBA amendments will take direct effect.

### ***Infringement***

The issues in this case related to the changes to the claim brought about by the amendment following the TBA decision. At first instance, the issues of infringement turned on the construction of two phrases: “*wherein the access authorisation data are transmitted as a bit pattern*” and “*access class bit*”. On the issue of infringement, Birss J had found against IPCoM on the former but for IPCoM on the latter.

On appeal, IPCoM submitted that, having construed “*as a bit pattern*” as he did, infringement could in fact be made out and that an important piece of HTC’s expert evidence had simply been overlooked at first instance. In allowing their appeal, the Court held that, although it was regrettable that Birss J was not specifically directed to the relevant point of expert evidence, it should not act as a bar to success on appeal where the relevant point of evidence was unchallenged.

HTC’s cross-appeal on the construction of “*access class bit*” relied, in part, on the fact that the claim language had been amended from “*access class information*” indicated to the skilled person that only a single physical digital bit would satisfy the claim. Although the Court did not go on to consider whether limited reference to the mere fact of amendment (said to indicate that something must have changed) was formally admissible, it was not convinced that the fact of this amendment would lead the skilled person to conclude the patentee was using the language of the claim in a narrow, literal sense.

### ***Added matter***

HTC’s assertion that the construction reached by Birss J had the effect of adding matter was also dismissed. HTC argued that as the claim in question had been based on a specific embodiment, it was not permissible to take certain features and not others as to do so was to disclose a new combination. Noting that it cannot be necessary for features that are not of significance to the way the invention is carried out by the embodiment to be included in the claim, the Court found that the teaching of the embodiment was sufficiently general to encompass variants which had no material effect on the way the invention worked. Whilst the amended claim did not require features of a single bit pattern or a single access class bit, neither did the combination disclosed by the embodiment. As such, the amended claim did not disclose any added matter.

### ***Discretion to allow amendments***

The question of the admissibility of prosecution history also reared its head in relation to HTC’s submission that Birss J should have refused the amendments as a matter of discretion. HTC contended that Birss J had not taken due account of IPCoM’s avowed intention to obtain a claim which was equivalent in scope to that approved by the TBA. Contrasting the judge’s construction of “*as a bit pattern*” and his finding as to the “*better translation*” of the phrase, HTC asserted that the amended English claim was now wider in scope than the TBA approved German claim.

In dismissing their cross-appeal, the Court endorsed Birss J’s finding that IPCoM’s averred intention was irrelevant to the question of discretion. The Court went on to hold that Birss J had not been in a position to make a finding that the scope of the TBA approved German claim was different to that of the amended English claim. In doing so, the Court drew a subtle, but important, distinction between the exercise of translation and construction of a foreign language claim. In

reaching his conclusion as to the “better translation” of the German claim, Birss J had relied on the evidence of a translator which had been coloured by events before the TBA. The Court reiterated their view that what happened at the TBA was not a legitimate aid to construction. Referring to its own decision in **Actavis v Eli Lilly** ([2015] EWCA Civ 555; [2015] Bus LR 1068), the Court took this opportunity to comment on the impossible burden that reliance on prosecution history places on the skilled reader if it were to be recognised as a legitimate aid to construction.

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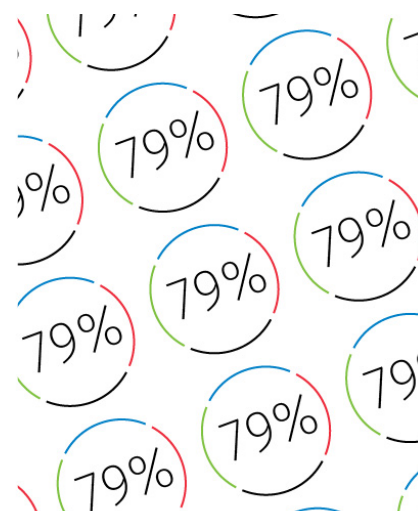
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OJ 1994, 541) *The ‘gold standard’ of the European Patent Office’s Board of Appeal is that “any amendment can only be made within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of the documents as filed” (G 3/89, OJ 1993,117; G 11/91, OJ 1993, 125).*“>Added matter, [G 1/93](#), OJ 1994, 541) *The ‘gold standard’ of the European Patent Office’s Board of Appeal is that any amendment can only be made within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of the documents as filed (G 3/89, OJ 1993,117; G 11/91, OJ 1993, 125).*“>Amendments, [electricity](#), [electronics](#), and [electromagnetism](#) and includes control systems, medical electrical engineering, electrical energy systems, high-performance electronics, robotics, electric motors, digital and analogue circuits, circuit topologies, oscillators, amplifiers, filters, semiconductor components, silicon-based components, semiconductor systems, sensors, transistors, passive components, MEMs, smartcards, signal processing systems, digital signal processing, coding techniques, computer-related inventions, computer technology, embedded software, telecommunications, GSM/UMTS/CDMA systems and typologies, telecommunications coding techniques, positioning technologies, TFT/LCD/Plasma/(O)LED displays, Plasma physics, Solar cells, Semiconductor physics, Deposition techniques, etching techniques, thin film techniques, epitaxy techniques, Plasma processing, MRI, Thermodynamics, Nuclear physics, Nuclear energy, Nuclear applications in medicine, Geophysics, Aerodynamics, Sustainable energy technologies, Computational physics”>Electrical Engineering, [United Kingdom](#)

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